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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/680,852      | 10/07/2003  | Dennis Miller        | 2002DE434           | 5823             |

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12/02/2005

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| EXAMINER |
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METZMAIER, DANIEL S

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| ART UNIT | PAPER NUMBER |
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1712

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/680,852

Applicant(s)

MILLER ET AL.

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/7 & 11/25/2003; 3/23 & 4/29/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/23/04 & 11/25/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-24 are pending.

#### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12 and 15-24, drawn to a microemulsion composition, classified in class 516, subclass 58.
  - II. Claim 13, drawn to a method of treating skin, classified in class 424, subclass 401.
  - III. Claim 14, drawn to a method for cleaning a hard surface or clothing, classified in class 134, subclass 40.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Group II or III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the compositions may be used in a materially different process such as in cosmetic compositions in processes of treating skin or alternatively in contacting hard surfaces or cleaning clothing.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Richard P. Silverman on October 12, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-12 and 15-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13 and 14 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Priority***

7. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

8. The Information Disclosure Statement filed April 29, 2004 referring to copending application number 10/272,097 is acknowledged. Attention is directed to the corresponding US PGPUB 2003/0086892 A1 to Klug et al cited on the Form PTO-892.

The Information Disclosure Statement filed March 23, 2004 referring to copending application number 10/338,452 is acknowledged. Attention is directed to the corresponding US PGPUB 2003/0161852 A1 to Miller et al cited on the Form PTO-892. EP 1 327 439 also corresponds to application number 10/338,452 but is a publication by the instant inventors published less than a year prior to the instant filing date.

The information disclosure statement filed March 23, 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because reference BA and CA refer to the wrong publication number and references CA and CB fail to provide the publication source and date. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Attention is directed to the Form PTO-892 for a proper citation of related abstracts.

### ***Claim Objections***

9. Claims 6-9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1

specifically defines "component d)" as a surfactant having a specified chemical formula, which is within the class of nonionic surfactants. Claims 6-9 define "component d) outside of the formula specified in claim 1.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-12 and 15-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite as to the metes and bounds of the claimed subject matter since the claim sets forth a "microemulsion which comprises polyethylene glycol and: . . . 1 to 98 % by weight of a polyethylene glycol" (emphasis added). The claim sets forth "polyethylene glycol" as a component twice, once with a concentration limitation and once without said concentration limitation. The limitations are modified by "and". It is unclear if said claimed recitations of polyethylene glycol represent different polyethylene glycols and how one skilled in the art would determine how much of each of the "polyethylene glycol" to attribute to the concentrations ranges claimed.

Applicants' intent in the claim 5 alternative grouping is unclear. Since the claim appears to include all the species, i.e., "the water-insoluble liquid comprises oils, hydrocarbons, and mixtures thereof", the recitation of the "mixtures thereof" species would be redundant. To the extent applicant intends an alternative grouping, claim 5

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employs open transitional language, i.e., "comprising", which is improper for alternative groupings and would render the scope of said alternative grouping indefinite.

Claims 6-9 are indefinite to the extent said surfactant species are contemplated as additional ingredients.

Claim 16 recites R<sup>1</sup>, which lacks proper antecedent basis in claim 1. It is believed R<sup>1</sup> should be R'.

In claim 20, it is unclear what applicants reference to "the surfactant" is intended to include and what surfactants are included in the concentration determination. Please contrast claims 6-9.

Claim 10 is indefinite since the determination of the degree of solubilization has not been specifically defined and an emulsion is a dispersion of one ingredient into another. A microemulsion is a thermodynamically stable emulsion. Claim 1 defines component a) as water insoluble. It is unclear what are the metes and bounds of claim 10, since the phases of the emulsions would be expected to be the water insoluble component a) and an aqueous phase. Since component a) is claimed as water-insoluble, it is inconsistent to also claim a degree of solubility in the emulsion without setting forth a specific determination method.

### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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13. Claims 1-2, 4-6, 8, 10-12, 15-17, 20-21, and 23 are rejected under 35

U.S.C. 102(b) as being anticipated by Colgate-Palmolive Company, WO 95/14764.

Colgate-Palmolive Company (example 1, A, and page 38, lines 26 et seq) discloses microemulsion compositions having (a) 0.4 to 10wt% (0.8 wt% exemplified) of perfume, which is a hydrocarbon ingredient, (b) 0.1 to 10 wt% (4.0 wt% exemplified) PEG 400 or 600, (c) balance of water, (d) 3.0 wt% exemplified C13-15 fatty alcohol 7EO,4PO, and 0.1 to 20 wt% (4.0 wt% exemplified) anionic surfactant.

The perfumes are characterized (page 39, lines 1-3) as water-insoluble and as the essential hydrocarbon ingredient of 0.1 to 10 wt%.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).



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16. Claims 1-12 and 15-24 are rejected under 35 U.S.C. 102(b) as anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Guthauser et al, US 5,290,555. Guthauser et al (examples and claims, particularly examples 4, 5, and 8) disclose translucent emulsion compositions. While translucent is not deemed to be the same as transparent, said terms are not distinct from each other since a translucent composition has some transparency to a degree depending on the thickness the transparency is measured. The degree of solubilization of component a) would have been expected to have been inherent because the emulsions are translucent and have a high degree of solubilized oil phase to form the translucent appearance.

To the extent the Guthauser et al compositions differ from the claims in the characterization of the transparency, the use of additional components, Guthauser et al exemplifies and teaches (columns 1, 2, and 4) compositions having a emulsion droplet size within the microemulsion size, i.e., less than 50 microns, as well as macroemulsions; characterizes the emulsions as translucent, which is a property of some microemulsions; and intends to produce colored emulsions including translucent emulsions. Guthauser et al (column 4, lines 3 et seq) teach a number of materials as obvious additives to the cosmetic compositions reading on the electrolytes of claim 11.

It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to vary the components disclosed in the Guthauser et al reference for the desired cosmetic use also disclosed in the Guthauser et al reference in the form of transparent microemulsions as obvious conventional art known forms. The use of the disclosed additives reading on the electrolytes of claim 11 would have been obvious to

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one of ordinary skilled in the art at the time of applicants' invention for the advantage of their art known function as a emulsifier and/or cosmetic additive.

### ***Double Patenting***

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 1-12 and 15-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No. 10/338,452. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims encompass the emulsion system of application no. '452 and at least dependent claim 7 of '452 sets forth the instant surfactant component d), which the remaining claims of '452 are generic. The transparency is an inherent property of microemulsions and therefore at least overlaps the '452 claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


**Conclusion**

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel S. Metzmaier  
Primary Examiner  
Art Unit 1712

DSM